

- C) Cells that are genetically engineered or cells that are not genetically engineered.

The Examiner stated that the inventions are distinct, each from the other because of the following reason: Hollow fiber, a disc, a sphere, or a microcapsule are structurally distinct from each other. Furthermore, since the claimed microcapsule is improved by increasing the pore sizes, and since hollow fiber, a disc, a sphere do not necessarily [sic] have the same pore size as the claimed microcapsule, one of ordinary skill in the art would not have expected that the claimed method, using the claimed microcapsule, could also be successfully applied to hollow fiber, a disc, and a sphere.

The Examiner stated that the cells of B) are structurally and functionally distinct from each other. One of ordinary skill in the art would not have expected that the claimed cells could be successfully grafted, and especially could produce hormone or insulin, because each cell has different properties [sic].

The Examiner stated that the cells that are not genetically engineered are structurally, and functionally distinct from cells that are genetically engineered.

The Examiner advised applicants that upon the allowance of a generic claim, applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. §1.141 and that if claims are added after the election, applicants must indicate which are readable upon the elected species.

Applicants hereby elect, with traverse, to prosecute the microcapsule species of (A) (device), the endocrine cells species which are insulin producing cells of (B), and the cells that are not

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genetically engineered species of (C).

Applicants, however, respectfully request that the Examiner reconsider and withdraw the election requirement.

Applicants maintain that the allegedly distinct species, a hollow fiber, a disc, a sphere, a microcapsule, genetically engineered cells, and not genetically engineered cells, are all recited in dependent claims, which would be deemed free of prior art if their respective independent claim is deemed free of prior art. Accordingly, applicants respectfully submit that a search directed to the independent claim should uncover any art relating to the alleged species. Therefore, applicants respectfully submit that a search directed to the independent claim would be sufficient.

Applicants maintain that the Examiner considers independent claim 1 "generic". Claims 3-4 include all the limitations of generic claim 1 with respect to a device comprising a semipermeable membrane. Claims 14-19 include all the limitations of generic claim 1 with respect to cells which secrete a hormone or a biologically active substance. Claims 5-7 and 8 include all the limitations of generic claim 1 with respect to viable cells or tissue comprising the viable cells which may be from a xenogeneic donor, an allogeneic donor, derived from the subject or genetically engineered. Likewise, claims 52 and 53, which both depend on claim 48, which itself depends on claim 1, include all the limitations of generic claim 1 with respect to a device comprising a semipermeable membrane. Applicants maintain that the pending claims define a single inventive concept. Applicants maintain that generic claim 1 recites allowable subject matter.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw the restriction requirement to distinct

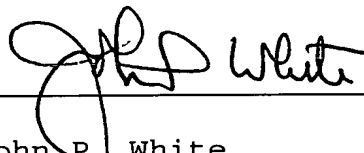
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species and examine all of the pending claims, i.e. claims 1-23 and 43-53, for all of the claimed species on the merits.

If a telephone conference would be of assistance in advancing the prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone at the number provided below.

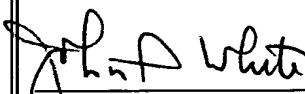
No fee is deemed necessary in connection with the filing of this Communication. However, if any fee is required, authorization is hereby given to charge the amount of such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

 9/8/99
John P. White Date
Reg. No. 28,678